

*#10/Reconsideration
T. McBeth-Brown
5/1/01*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Appln. of: Robert Filepp et al.

Group Art Unit 2153

Serial No.: 09/369,649

Examiner: Moustafa M. Meky

Filed: August 6, 1999

Title: INTERACTIVE COMPUTER SYSTEM AND
METHOD OF OPERATION

REPLY TO OFFICIAL ACTION

Assistant Commissioner of Patents
Washington, D.C. 20231

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Sir:

In reply to the Official Action dated October 16, 2000, Applicants submits the below-noted remarks, and, request that their application be reconsidered in light of those remarks.

REMARKS

THE OFFICIAL ACTION

In the official action dated October 16, 2000 (Action), the Examiner:

- Noted entry of the disclaimer Applicants previously submitted; and, thereafter,
- Rejected Applicants' pending claims 1-36 pursuant to 35 U.S.C. §102 (b) as allegedly anticipated in view of U.S. patent 4,278,973 issued to Hughes et al.

APPLICANTS' RESPONSE

SUMMARY

Applicants would respectfully submit their invention as presented in pending claims 1-36 has not been shown to be anticipated or otherwise unpatentable in view of Hughes et al., or any other art of record. Applicants' claims 1-36 are not invalid pursuant to 35 U.S.C. §102(b) or any other provision of the Patent Statute. The Examiner has failed to establish a *prima facie* case of anticipation against Applicants' claims 1-36. The Examiner has impermissibly interpreted Applicants' claims by disregarding the express meaning of claim limitation elements as presented in Applicants' disclosure. Instead of interpreting Applicants' claim elements as having the meaning defined in Applicants' disclosure, as required by law, the Examiner has instead unreasonably interpreted Applicants' claim elements without any limitation and without regard to Applicants' teaching. Further, in addition to failing to properly interpret Applicants' claim elements, the Examiner has failed to demonstrate the presence of each and every element of Applicants' respective claims 1-36 in the asserted Hughes et al. patent. Still further, Applicants' would respectively submit that the Hughes et al. patent the Examiner relies upon to establish anticipation of Applicants' claim 1-36, is incompetent as a reference because Hughes et al. fails to provide enablement of the features the Examiner asserts it for.

THE EXAMINER'S CONTENTIONS

As noted, in the Action, the Examiner rejected Applicants' claims 1 - 36 pursuant to 35 U.S.C. §102(b) as anticipated in view of Hughes et al. In making the rejection, the Examiner asserted with regard to Applicants' claims 1-20, that he believed Hughes et al. discloses a system which includes a server in a computer network to present interactive applications at user stations. Further, the Examiner contended the Hughes et al. system provides and stores application objects; i.e., what the Examiner interpreted

as "display data", on the network and generates a display interface including partitions for presenting the applications at respective reception systems.

Finally, with regard to Applicants' claims 21-36, the Examiner contended that claims 21-36 are "similar in scope to claims 1-20, and they [claims 21-26] are rejected under the same rational [as claims 1-20]." Action p. 2, lns. 10-19.

THE LAW :

To Deny Patentability on Grounds of Anticipation, The Examiner Must First Establish a *Prima Facie* Case

The Court of Appeals for the Federal Circuit and its predecessor the Court of Customs and Patent Appeals have established that the Patent and Trademark Office has the burden of making a *prima facie* case whenever the Office seeks to deny the patentability of claimed subject matter. See, e.g., *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). As Judge Newman explained in speaking for the Court in *Oetiker*:

The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990). The term "*prima facie* case" refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument. See *In re Spada*, *supra*; *In re Corkill*, 771 F.2d 1496, 1500, 226 USPQ 1005, 1008 (Fed. Cir. 1985); *In re Caveny*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985); *In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984).

If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent. See *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985); *In re Rinehart, supra.* (emphasis added).

In re Oetiker, 24 U.S.P.Q.2d at 1444.

Accordingly, in view of the Judge Newman's remarks in *Oetiker*, it is clear that where a Patent and Trademark Officer examiner undertakes to reject the patentability of an applicant's invention on grounds of anticipation, the examiner bears the burden of first making out a *prima facie* case. And, still further, as Judge Newman explains, if the examiner fails to establish that *prima facie* case, the applicant is entitled to a patent for his invention without showing more. *Oetiker, id.* See also *In re King*, 801 F.2d 1324, 231 USPQ 136, 138-39 (Fed. Cir. 1986); *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970).

The First Step in an Anticipation Analysis Is Interpretation of the Claims

In defining the procedure for establishing anticipation, the Federal Circuit pointed out in *Helifix Ltd. v. Blok-Lok Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000), that anticipation analysis is a two-step process - the first step being claim interpretation, and, the second step being comparison of the properly interpreted claim to the art. Specifically, Judge Schall, speaking for the Court said:

An invention is anticipated under 35 U.S.C. Section 102(b) if it "was ... described in a printed publication in this . . . country . . . more than one year prior to the date of application for patent in the United States." 35 U.S.C. Section 102(b). **The first step of an anticipation analysis is claim construction.** See *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 714, 48 USPQ2d 1911, 1915 (Fed. Cir. 1998).

The second step in an anticipation analysis involves a comparison of the construed claim to the prior art. See *Key Pharms.*, 161 F.3d at 714, 48USPQ2d at 1915. (emphasis added)

Helifix Ltd. v. Blok-Lok Ltd. 54 USPQ2d at 1303.

With regard to claim interpretation, the Federal Circuit has long maintained that while there is a difference between claim analysis undertaken in the courts and that undertaken in the Patent and Trademark office, the Patent and Trademark Office, nonetheless, is required to interpret an applicant's claims "reasonably" and with regard to what the applicant has disclosed in his specification.

Specifically, and as explained by Judge Plager in *In re Morris*, 127 F3d 1048, 44 USPQ2d 1023, (Fed. Cir. 1997), the Patent and Trademark Office has traditionally asserted that claim language should be given its "broadest reasonable interpretation consistent with the applicant's specification" during prosecution. In his remarks, Judge Plager, noted that a line of cases favors conventional claim language be given its "broadest reasonable interpretation" during application prosecution, it being understood that "reasonable" requires the Patent and Trademark Office to interpret claim language as it would be understood by those skilled in the art in light of the applicant's specification.

Specifically, Judge Plager pointed out:

Some cases state the standard [for Patent and Trademark Office claim interpretation] as "the broadest reasonable interpretation," see, e.g., *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993), others include the qualifier "consistent with the specification" or similar language, see, e.g., *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Since it would be unreasonable for the PTO to ignore any interpretive guidance afforded by the applicant's written description, either phrasing connotes the same notion: as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. (Emphasis added)

In re Morris, 44 USPQ2d at 1027.

Indeed, the Patent and Trademark Office has acceded to the directives of the Federal Circuit in *Morris* and other cases of comparable holding, as it is obliged to do by law, and has expressly mandated adherence to those rulings by its patent examining corps in the Patent and Trademark Office Manual of Patent Examining Procedures, (MPEP). Specifically, the MPEP expressly requires that claims during prosecution be “given the broadest reasonable interpretation consistent with the [applicant’s] specification.” see MPEP, Section 2111, (7th ed, rev. 1, 2000).

Moreover, the MPEP notes that not only must the examiner provide a reasonable interpretation in light of applicant’s specification, but further, to the extent the applicant has defined in his specification the term used in his claims, the examiner is required to follow applicant’s specification description. See MPEP, Section 2111.01; see also *In re Cortright*, 165 F3d 1353, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999); *In re Morris*, 44 USPQ2d at 1027;

The Second Step in an Anticipation Analysis Is Comparison of the Properly Interpreted Claim to the Art

As noted, the Federal Circuit in *Helifix Ltd.* pointed out that the second step of an anticipation analysis includes comparison of the properly interpreted claim with the cited art, *Helifix Ltd.*, 54 USPQ2d at 1303. More specifically, the court explained that to find anticipation, a single prior art reference must disclose “each and every limitation of the claimed invention[,] ... must be enabling[,] and [must] describe ... [the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” (citing *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994)).

With regard to the presence of “each and every” element of the claimed invention being present in the reference relied on to establish anticipation, the Federal Circuit in

In re Robertson, 49 USPQ2d 1949 (Fed. Cir. 1999) held that each and every element as set forth in the claim must be found, either expressly or inherently described, in a single reference (citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Further, the Court went on to note that:

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q.323, 326 (C.C.P.A. 1981).

In re Robertson, 49 USPQ2d at 1950-1951.

As to the noted prerequisite that the reference relied on be enabling with regard to the claimed invention contended to be anticipated, the Federal Circuit and its predecessor, the Court of Customs and Patent Appeals (CCPA), have continually maintained the importance of that requirement going back over a long line of cases including: *Helifix Ltd. v. Blok-Lok Ltd.* 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671, (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); *In re Coker*, 463 F.2d 1344, 175 USPQ 26, (CCPA 1972); and *In re Brown*, 329 F.2d 1006, 141 USPQ 245, (CCPA 1964). The underlying principle is clearly articulated in *In re Brown*, and goes to the "described in a printed publication" language requirement of 35 U.S.C. § 102(b). Specifically, and as explained in *Brown*, to be an anticipation, the publication relied on must "place appellant's invention in possession of the public"; particularly, and as described in *Robinson on Patents*, Section 330 (1890), the *Brown* court noted "'the description [of the publication relied on] must

place the invention in the possession of the public as fully as if the art or instrument itself had been practically and publicly employed. In order to accomplish this, it [the publication] must be so particular and definite that from it alone, without experiment or the exertion of his own inventive skill, any person versed in the art to which it appertains could construct and use it.'" *In re Brown*, 141 USPQ at 249.

**THE EXAMINER HAS FAILED TO MAKE A PRIMA FACIE CASE OF
ANTICIPATION OR OTHER UNPATENTABILITY AGAINST
APPLICANTS' CLAIM 1-36**

Applicants would respectfully submit their invention as presented in pending claims 1-36 has not been shown to be anticipated or otherwise unpatentable in view Hughes et al., or any other art of record. Applicants' claims 1-36 are not invalid pursuant to 35 U.S.C. §102(b), or any other provision of the Patent Statute. The Examiner has failed to establish a *prima facie* case of anticipation against Applicants' claims 1-36. The Examiner has impermissibly interpreted Applicants' claims by disregarding the express meaning of claim limitation elements given in Applicants' disclosure. Specifically, Applicants' independent claims 1, 21 and 26 expressly recite a method for operating a server in a computer network to enable presentation of interactive applications. Further, Applicants' noted claims expressly recite that the subject interactive applications employ "objects", and that the screen partitions where the applications are to be presented, arise by "generating a display interface" from objects. Still further, Applicants expressly define in their specification what is meant by the term "objects", and what is meant by "generating a display interface."

However, instead of interpreting Applicants' claim elements as having the meaning described in Applicants' disclosure, as required by law, the Examiner has instead unreasonably and absent justification, interpreted Applicants' claim elements without limitation and without regard to Applicants' teaching. Specifically, rather than

applying Applicants' meaning of "objects", as provided in their specification, the Examiner, unreasonably and absent justification disregarded Applicants' meaning, and, instead, applied the overly broad, general term "display data." Likewise, and again unreasonably and absent justification, the Examiner disregarded Applicants' meaning of "generating a display interface" as defined in Applicants' specification, and instead, applied the overly broad general meaning of "generating a display interface", the Examiner's interpretation being without regard to any specific procedure.

Further, in addition to failing to properly interpret Applicants' claim elements, the Examiner has failed to demonstrate the presence of each and every element of Applicants' respective claims 1-36 in the asserted Hughes et al. patent. Specifically, and with regard to at least independent claims 1, 21, 26, the Examiner has not shown, among other things, that Hughes et al. discloses or suggests the step of providing interactive application that employ objects; and the step of generating a display interface and associated partitions, from objects, as expressly recited in Applicants independent claims 1, 21, 26.

Still further, Applicants' would respectively submit that the Hughes et al. patent the Examiner relies upon to establish anticipation of Applicants' claim 1-36, neither provides enablement, nor, puts the public in possession of: a method for creating interactive applications or screen partitions in any manner; or a method for creating interactive applications and screen partitions for them from objects, as Applicants teach and claim.

**The Examiner Has Failed to Properly Interpret
Express Elements of Applicants' Claims**

As pointed out, the Examiner in the Action fails to properly interpret express elements of Applicant claims 1-36. Specifically, and with regard to at least

independent claims 1, 21, 26, the Examiner has not properly interpreted, among other things, Applicants meaning of "objects" employed in interactive applications, as provided in their specification, or Applicants meaning of "generating a display interface", as defined in their specification.

With regard to the meaning of "objects" employed in interactive applications, Applicants explain and define at length in their specification, for example, at pp. 15-19 that "objects" are data structures of prescribed form, which are used to define interactive applications, enable interactive application distribution, and application storage in the network, as well as application presentation at the user's display. More specifically, and, for example, at p. 18, lns. 1-3, Applicants describe objects as predefined variable length records. Further, and again by way of example, at p. 15, lns 19-25, Applicants note that objects can include network data and program instructions, and can be distributed in the network for processing at, for example, the user reception system.

Accordingly, the Examiner's interpretation of objects in the Action simply as "display data", unreasonably disregards Applicants' definition of objects as data structures of prescribed form, and is improper. As pointed out by the Federal Circuit, in *Morris*, it is "unreasonable" for an examiner to "ignore interpretive guidance afforded by the applicant's written description", and that an examiner is required to take into account "whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 44 USPQ2d at 1027. Indeed, the Patent and Trademark Office MPEP at Section 2111.01 also requires, and can require, no less.

Accordingly, the Examiner's interpretation of "objects" as "display data", in view of Applicants' teaching, and at least the Federal Circuit's directives in *Morris* and the

Patent and Trademark Office's requirements in the MPEP, necessitate the Examiner interpretation of "objects" as simply "display data" be withdrawn and the interpretation indicated in the Applicants' specification of objects being data structures of prescribed form, be applied.

Continuing, and with regard to the meaning of "generating a display interface" as recited in Applicants' claims 1, 21, and 26, here also Applicants explain and define at length in their specification; for example, at pp. 15-19 concerning objects and the sample application given at pp. 138-142, what the interpretation of the recital is. More specifically, and, for example, at p. 15, lns. 23-26, Applicants describe that the screens presented at the user's monitor are each divided into addressable partitions, and the display text and graphics necessary to make up the partitions, as well as the program instructions and control data necessary to deliver and sustain the screens and partitions, are formulated from pre-created objects, objects being defined as noted above. Indeed, Applicants' claims 1, 21 and 26 expressly recite that the generating of the display interface arises for use of objects.

In view of the above, the Examiner's interpretation of "generating a display interface" simply as generating the interface without regard to any specific procedure, unreasonably disregards Applicants' description of generating the display interface from objects, and is unsupportable as a matter of law. Again, and, as described above, the Federal Circuit, in *Morris*, expressly held it is "unreasonable" for an examiner to "ignore interpretive guidance afforded by the applicant's written description", and mandated that an examiner take into account "whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 44 USPQ2d at 1027. See also the Patent and Trademark Office MPEP at Section 2111.01.

Therefore, in view of the Examiner's interpretation of "generating a display interface" without regard to any specific procedure, and Applicants' express teaching otherwise, and at least because of the Federal Circuit's directives in *Morris* and the Patent and Trademark Office's requirements in the MPEP, Applicants' would respectfully submit that the Examiner interpretation must be withdrawn, and the interpretation indicated in the Applicants' specification and claims, for "generating a display interface", of generating a display interface from objects, be applied.

The Examiner Has Failed to Show That Each and Every Element of Applicants' Claims Are Present in the Asserted Art

As pointed out, the Federal Circuit in, for example, *Helifix Ltd.* held that the second step of an anticipation analysis following claim interpretation includes comparison of the properly interpreted claim with the cited art. In that regard, the Federal Circuit has require that to establish the anticipation of a claimed invention, it must at least be shown that each and every limitation of the claimed invention is found expressly or inherently in the art asserted. *See also In re Robertson.*

In rejecting Applicants' claims 1-36, the Examiner contends that Hughes et al. anticipates Applicants' claimed invention. As noted above, however, Hughes et al. fails to disclose or suggest, at least, the steps of providing interactive application that employ objects; and the step of generating a display interface and associated partitions from objects, as expressly recited in Applicants independent claims 1, 21, 26. Further, since pursuant to 35 USC §112(4), "[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers" (35 UCS §112(4) (2000)), Hughes et al. also fails to disclose or suggest the noted limitation included in Applicants' claims 2-20; 22-25; and 27-36, based on their respective dependency for claims 1, 21, 26.

Upon review of Hughes et al. it is evident it neither discloses, nor suggests the step of providing interactive application that employ objects; or the step of generating a display interface and associated partitions from objects, in a method for operating a server to enable presentation of interactive applications. Instead, Hughes et al. proposes a video display terminal 3, including a microprocessor 7, read/write memory 14, refresh logic 19; line buffer 20 and associated elements contended to be able to present one or more screen partitions by the use of left and right horizontal margin identifiers provided by the terminal microprocessor 7. See Hughes et al. col. 2, ln. 45 - col. 4, ln. 5. Specifically, Hughes et al. explain that the problem of formatted display text interference between screen partitions can be suppressed by applying a left margin identifier byte and a right margin identifier byte in an otherwise conventional text data stream so that respective text formatting attributes can be confined to the appropriate partition. See Hughes et al. col. 4, ln. 46 - col. 5, ln. 5, ln. 56.

However, at no time does Hughes et al. disclose or suggest use of objects; i.e., data structure of prescribed form, for the applications, or for generating the screen partitions from objects. In fact, as will be discussed below, Hughes et al. provide no description in their specification for how the margin identifying bytes they propose for defining the partition horizontal boundaries are to be generated. Rather Hughes et al. merely indicate in their claims, than the margin identifying bytes are somehow provided from the terminal "processing means", presumably microprocessor 7. See Hughes et al. specification and claims 1-12.

Accordingly, Applicants would respectfully submit that Hughes fails to disclose or suggest each and every element of Applicants' claims 1-36.

**The Examiner Fails to Show the Asserted Art Enables or
Puts the Public in Possession of Applicants' Claimed Invention.**

As noted, the Federal Circuit and its predecessor, the CCPA, in a long line of cases; e.g., *Helifix Ltd.*; *In re Paulsen*; *In re Spada*; *In re Coker* and *In re Brown*, have required that asserted art be enabling and put the public in possession of a claimed invention in order to establish that the claimed invention as anticipated. In the rejection of Applicants' claims 1-36, however, not only has the Examiner failed to demonstrate that Hughes et al. is enabling with regard to Applicants' claimed invention, but, in fact, Hughes et al. lacks enablement for the subject matter it discloses.

Specifically, and as pointed out, both Applicants claims and their specification teach the use of interactive applications employing objects, and the generation of a display including partitions with the use of objects. Hughes et al. however, neither discloses or suggests the use of objects, and, rather, concerns only use of ordinary display text and text attribute data. Hughes does not enable Applicants' invention as claimed.

Indeed, and as noted above, Hughes et al. propose use of margin-identifying bytes for placement in an otherwise conventional data stream. See Hughes et al. col. 4, ln. 66 - col. 5, ln. 55. However, even this proposal is not enabled. Though Hughes et al. proposes use of margin-identifying bytes to avoid text and text attribute interference, the Hughes et al. specification is silent as to how and on what basis the margin-identifying bytes are generated. In fact, and as pointed out it is only in the Hughes et al. claims that a suggestion is provided that the margin-identifying bytes originate in the processing means of the proposed display terminal, see "processing means" in Hughes et al. claims 1-12. As noted, Hughes et al. nether enables, nor puts the public in possession of Applicants' invention as claimed, and it is respectfully submitted the Examiner has not shown it to.

CONCLUSION

Therefore, in view of the above, Applicants would respectfully submit the Examiner has failed to demonstrate a *prima facie* of anticipation against Applicants' claims 1-36 based on the disclosure of Hughes et al. Accordingly, the Examiner's rejection of Applicants' claims 1-36 pursuant to 35 U.S.C. §102(b) in view of Hughes et al. must be reconsidered and withdrawn.

As described, the Examiner has impermissibly interpreted Applicants' claims by disregarding the express meaning of claim limitation elements given in Applicants' disclosure concerning, for example, "objects" employed in the subject interact applications, and "generating a display interface." Rather than apply the interpretation of "objects", based on Applicants' specification teaching as shown, i.e., objects being data structures of prescribed form, the Examiner, unreasonably disregarded Applicants' teaching, and, instead, applied the overly broad, general interpretation of objects being, simply, "display data." Likewise, and again unreasonably, the Examiner disregarded Applicants' express teaching concerning "generating a display interface" as disclosed in Applicants' specification; i.e., generating a display interface from objects, and, instead, the Examiner applied the overly broad, general interpretation of "generating a display interface", as being generating a display interface without regard to any specific procedure. *See, e.g., In re Morris*; MPEP, Section 2111.01.

Further, in addition to failing to properly interpret Applicants' claim elements, the Examiner has failed to demonstrate the presence of each and every element of Applicants' respective claims 1-36 in the asserted Hughes et al. patent. Specifically, the Examiner has not shown, among other things, that Hughes et al. discloses or suggests the step of providing interactive applications that employ objects; and the step of generating a display interface and associated partitions, from objects, as included in Applicants claims 1-36. *See, e.g., In re Robertson*.

As well, Applicants' would respectively submit that the Hughes et al. patent the Examiner relies upon to establish anticipation of Applicants' claim 1-36, neither provides enablement, nor, puts the public in possession of: a method for creating interactive applications or screen partitions in any manner; or a method for creating interactive applications and screen partitions for them from objects, as Applicants teach and claim. See, e.g., *Helifix Ltd.; In re Brown*.

Therefore, Applicants would respectfully submit the Examiner has failed to demonstrate a *prima facie* of anticipation against Applicants' claims 1-36, and the Examiner's rejection of Applicants' claims 1-36 pursuant to 35 U.S.C. §102(b) must be reconsidered and withdrawn.

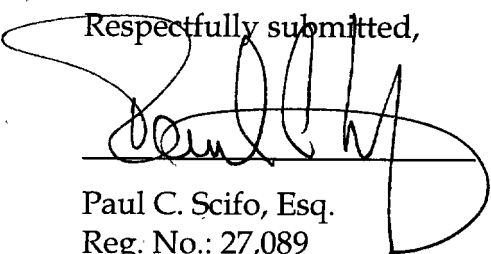
Additionally, Applicants would further respectfully submit that not only are their claims 1 -36 not anticipated by Hughes et al, but, further, neither are they obvious and thereby unpatentable in view of Hughes et al. As noted, Hughes et al. fails to disclose or suggest fundamental aspects of Applicants' claimed invention, particularly, and for example, Applicants' teaching of interactive applications employing objects and the generating of a display interface including partitions with the use of objects. Rather, Hughes et al. concerns an entirely different approach from Applicants, by relying on partition margin-identifying bytes, which are generated in some undisclosed fashion and placed into an otherwise conventional display data stream. As such, Hughes et al. even when viewed in the most favorable light, fails to disclose or suggest the express limitation of the claims that define Applicants' invention as a whole. Additionally, in view of the substantially different technological approach taken by Hughes et al. relative to Applicants' teaching, significant and substantial engineering changes would have to be considered, and determinations made as to whether such changes could be made in order to assess if the Hughes et al. system could be made to even approximate Applicants' system. Further, such engineering changes are not disclosed in the art of

record, and would themselves rise to the level of invention if they could be undertaken at all. Accordingly, the disclosure of Hughes et al. does not render Applicants' claimed invention obvious.

Therefore, in view of the noted-noted remarks, Applicants would respectfully submit that their invention as claimed is patentably distinguished from the art or record, and that the Examiner's rejection of Applicants' claim 1-36 pursuant to 35 U.S.C. §102(b) on contended grounds of anticipation of the claimed subject matter in view of Hughes et al. is without basis in law or fact. Accordingly, Applicants, requests reconsideration of their application and issuance of a patent thereon.

Dated: February 15, 2001

Respectfully submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to the Assistant Commissioner of Patents Washington, D.C. 20231, on February 15, 2001

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